

## REMARKS

Applicant respectfully requests reconsideration of this application as amended.

In the Office Action, claims 1-43 were pending in the application. Claims 1-43 stand rejected. In this response, claims 6, 18, 30, and 42 have been canceled without prejudice. Claims 1, 4-5, 8-9, 11, 13, 16-17, 20-21, 23, 25, 28-29, 32-33, 35, 37-38, and 43 have been amended. Thus, claims 1-5, 7-17, 19-29, 31-41, and 43 remain pending. No new matter has been added.

Claim 37 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,524,193 of Covington et al. ("Covington"). In view of the foregoing amendments, it is respectfully submitted that claim 37 include limitations that are not disclosed by Covington. Specifically, claim 37 includes a limitation of combining a paper document and a multimedia annotation to form a multimedia document as a part of reproducing the paper document using a document reproduction system. This limitation is absent from Covington. Therefore claim 37 is not anticipated by Covington.

Claims 1-4, 7-8, 13-16, 19-20, 25-28, 31-32, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Covington in view of U.S. Patent No. 5,337,362 of Gormish et al. ("Gormish"). Claims 5-6, 9-10, 17-18, 21-22, 29-30, 33-34, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Covington in view of Gormish and U.S. Patent No. 6,572,661 of Stern ("Stern"). Claims 11-12, 23-24, 35-36, and 43 are rejected under U.S.C. 103(a) as being unpatentable over Covington in view of Gormish and U.S. Patent No. 5,880,740 of Halliday ("Halliday").

In view of foregoing amendments, it is respectfully submitted that the currently pending claims of the present application include limitations that are not disclosed or suggested by the cited references. Specifically, independent claim 1 recites as follows:

1. A method comprising:

creating a multimedia annotation for a paper document, the multimedia annotation including at least one of an audio sound and a video clip; and

combining the paper document and the multimedia annotation to form a first multimedia document, wherein the first multimedia document is generated as a part of reproducing the paper document via a document reproduction system.

(Emphasis added)

Independent claim 1 requires a multimedia annotation that includes at least one of an audio sound and a video clip and combining a paper document with the multimedia annotation to form a multimedia document as a part of reproducing the paper document via a document reproduction system. The above limitations are absent from the cited references, individually or in combination.

Rather, Covington relates to a document editing software that provides a method for annotating an electronic document, rather than a paper document (see, Abstract and Summary of Covington). It is respectfully submitted that Covington fails to disclose or suggest the above limitations recited in claim 1.

Gormish relates to a method for placing digital data on a plain paper. The digital data of Gormish does not appear to be multimedia annotation, particularly, the multimedia annotation having at least one of an audio sound and a video clip.

Neither Covington nor Gormish, individually or in combination, discloses or suggests that the multimedia document having multimedia annotation, such as, for example, an audio sound or a video clip, etc., is generated as part of reproducing a paper document.

In addition, there is no suggestion in the cited references to combine Covington and Gormish. Covington relates to an editing application for the electronic documents, which cannot reasonably be applied to a paper document, while Gormish relates to processing a paper document. Covington and Gormish deal with significantly different problems and their approaches are significantly different. It is respectfully submitted that it lacks the motivation to combine Covington with Gormish.

Furthermore, even if, for the sake of the arguments, Covington and Gormish were combined, such a combination still lacks the limitations set forth above. For at least the reasons set forth above, Stern and Halliday also fail to disclose or suggest the above limitations. Therefore, independent claim 1 is patentable over the cited references.

Similarly, independent claims 13, 25, and 37 include limitations similar to those recited in claim 1. Thus, for at least the reasons similar to those discussed above, claims 13, 25, and 37 are patentable over the cited references.

Given that the rest of the claims depend from one of the above independent claims, it is respectfully submitted that these claims are also patentable over the cited references. Withdrawal of the rejections is respectfully submitted.

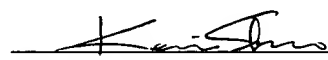
In view of the foregoing, Applicant respectfully submits the present application is now in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,

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Date: 1/20/2004

  
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